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09/813,540	03/21/2001	Ryan Giffin Moore	81915-1281	3697

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EXAMINER

BOYER, CHARLES I

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/02/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/813,540	Applicant(s) Moore et al
	Examiner Charles Boyer	Art Unit 1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Mar 21, 2001

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-50 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-50 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) Other: _____

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DETAILED ACTION

Double Patenting

1. Claims 1-16 of this application conflict with claims 1-16 of Application No. 09/802591. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-16 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-16 of copending Application No. 09/802591. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The nonstatutory double patenting rejection is based on a judicially-created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-50 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-37 of copending Application No. 09/813620. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The effervescent particle of 09/813620 may be anhydrous sodium perborate.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "compound" in claims 1-50 is used by the claim to mean "a composition with sodium perborate and a liquid," while the accepted meaning is "a substance whose molecules consist of unlike elements and whose constituents cannot be separated by physical means."

8. Claim 19 is confusing because it is a method for making an effervescent compound, however none of the steps of the claim include any effervescent compounds. The claim requires a liquid and a carrier only. Claims 35, 39, 43, and 47 are confusing because they refer to "the compound" however this compound is not defined.

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Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The examiner notes that anhydrous sodium perborate is very well known in the art as an effervescent compound. It is further noted that the liquid ingredient of claim 1 is present in an amount "up to approximately 50% by weight of the compound" which may include 0%. Therefore, all that is required in claim 1 is sodium perborate, a well known compound. Accordingly, there are perhaps hundreds of references that would anticipate at least claim 1 of the present invention.

10. Claims 1, 5, 10, 12, 17-19, 24, 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Kemper et al, EP 53,859.

Kemper et al teach bleach activator granules containing anhydrous sodium perborate (see abstract). An example of such a composition comprises 15% sodium perborate monohydrate, 20.5% sodium peroxoborate, 14% ethoxylated alcohol, 25% myristic acid, and 10% zeolite (page 9, example IV). As this reference exemplifies all material limitations of the claims at hand, the reference is anticipatory.

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11. Claims 1, 5, 10, 12, 17-19, 24, 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Baillely et al, WO 99/58444.

Baillely et al teach effervescent particles comprising anhydrous sodium perborate and a diluent (see abstract). An example of such a composition comprises 45% anhydrous sodium perborate, 20% ethoxylated alcohol, and 10% zeolite (page 48, example D). As this reference exemplifies all material limitations of the claims at hand, the reference is anticipatory.

12. Claims 1, 5, 10, 12, 17-19, 24, 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al, 4,772,412.

Green et al teach non-aqueous liquid detergents comprising anhydrous sodium perborate (see abstract). An example of such a composition comprises 20% anhydrous sodium perborate, 31.7% ethoxylated alcohol, 30% sodium tripolyphosphate, and 6% sodium carbonate (col. 8, example I). As this reference exemplifies all material limitations of the claims at hand, the reference is anticipatory.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baillely et al, WO 99/58444.

Baillely et al are relied upon as set forth above. The diluents of the invention are present in a liquid or liquefied form (page 4, lines 15-18) and suitable diluents are detergent surfactants, inorganic or organic salts (pages 7 and 8). The effervescent particles may be present in laundry or dishwashing compositions and may be pressed into tablets (pages 9 and 10). Baillely et al do not specifically teach their compositions for use in carpet or glass cleaners. The examiner maintains these applications are merely the ultimate intended use of the compositions. It is well established that the mere recital of a different intended use in a claim does not distinguish the claim over a composition containing the same ingredients in the same proportions for a different purpose in the prior art. See *In re Zierden*, 162 USPQ 102 (CCPA 1969). Claims in a patent application cannot be held to involve invention if the composition defined in such claims is not novel, and patents for old compositions of matter based on new use of such compositions without change therein may not lend patentability to claims. See *In re Thuan* 30 C.C.P.A. 979, 135 F.2d 344, 57 USPQ 324.

15. Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al, 4,772,412.

Green et al are relied upon as set forth above. The non-aqueous liquid may be a surfactant, monohydric or polyols (col. 1, lines 33-42). Green et al do not specifically teach their

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compositions for use in carpet or glass cleaners. The examiner maintains these applications are merely the ultimate intended use of the compositions. It is well established that the mere recital of a different intended use in a claim does not distinguish the claim over a composition containing the same ingredients in the same proportions for a different purpose in the prior art. See *In re Zierden*, 162 USPQ 102 (CCPA 1969). Claims in a patent application cannot be held to involve invention if the composition defined in such claims is not novel, and patents for old compositions of matter based on new use of such compositions without change therein may not lend patentability to claims. See *In re Thuau* 30 C.C.P.A. 979, 135 F.2d 344, 57 USPQ 324.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Boyer whose telephone number is (703) 308-2524. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Charles Boyer

December 31, 2001

